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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Genescreen, Inc.

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Serial No. 75/600,523

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R. Darryl Burke of McKool Smith for Genescreen, Inc.

Heather D. Thompson, Trademark Examining Attorney, Law Office 103 (Daniel Vavonese, Acting Managing Attorney).

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Before Simms, Seeherman and Wendel, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Genescreen, Inc. has appealed the final refusal of the Trademark Examining Attorney to register SOFTOUCH for "laboratory sample collection system for DNA analysis comprising sponge-tipped swab, plastic tube and cap, sample box and sample shipping envelope" in Class 9, and "collecting, analyzing and laboratory testing of cell

samples for DNA analysis" in Class 42.[1] Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SOFT TOUCH, previously registered for "lancet device for extracting blood for blood test,"[2] that when used in connection with applicant's identified goods and services, it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We affirm the refusal of registration with respect to both classes.

Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

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[1] Application Serial No. 75/600,523, filed December 1, 1998, and asserting first use and first use in commerce in May 1996.
[2] Registration No. 2,099,102, issued September 23, 1997 to Boehringer Mannheim Corporation, assigned to Roche Diagnostics Corporation.

Turning first to the marks, they are virtually identical. They are identical in pronunciation and connotation, with both marks suggesting that the respective products are gentle and not painful to the party from whom the blood or buccal cells are being obtained. The marks are also extremely similar in appearance. Both are for the words SOFT TOUCH. The only difference is that in applicant's mark the words are telescoped into SOFTOUCH. However, the impression of this mark as being the words SOFT TOUCH is not changed by this telescoping. Applicant has applied for its mark as a typed drawing, which means that its protection would not be limited to a particular type style. Further, we note that as actually used, applicant depicts its mark as "SofTouch", thus emphasizing the fact that it is made up of the two words.

This brings us to a consideration of the registrant's goods and applicant's goods and services. As the Examining Attorney has pointed out, it is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services or the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the

goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. **In re International Telephone & Telegraph Corp.**, 197 USPQ 910 (TTAB 1978).

In this case, applicant's laboratory sample collection system for DNA analysis is clearly related to the registrant's lancet device for extracting blood for blood tests. Although the products obtain the samples in different manners, the question is not whether consumers are able to tell the products apart, but whether they will assume that they emanate from the same source if sold under confusingly similar marks. In this case, both products have the same purpose, i.e., to obtain cell samples, applicant's by means of a sponge-tipped swab for buccal cells within the cheek, and registrant's by means of a lancet to draw blood. Further, both products can be used to obtain cell samples for use in DNA analysis. In fact, applicant's own specimens show that it "utilizes blood as the preferred sample for the DNA analysis procedures." Applicant also has conceded "that blood can be used for genetic testing, ... and lancets are sometimes used to extract blood, the goods and services are not totally

unrelated." Brief, p. 8. Applicant has also acknowledged that a lancet may be used to gather samples for genetic analysis. Id.

Applicant asserts, however, that the registrant's lancets are not in fact used to obtain samples for DNA analysis, and that the purposes for which the blood is drawn is undefined. We agree that the registration does not limit the uses for the blood samples, but cannot accept applicant's position that this creates a meaningful difference. Because the identification is for "lancet device for extracting blood for blood test," we must deem the lancets to be used for blood tests for all purposes. See **In re Elbaum**, 211 USPQ 639 (TTAB 1981) (where there are no limitations in the identification of goods in a cited registration as to their nature, type, etc., it is presumed that the scope of the registration encompasses all goods of the nature and type described). One purpose of blood tests, as shown by applicant's own statements and materials, as well as the NEXIS evidence of record,[3] is for

[3] See, for example, "By measuring variations in DNA structure from blood samples," *Drug Discovery/Technology News,* March 1999; "A variety of sources can be used for the original DNA sample, including ... whole blood," *Medical Laboratory Observer*, February 1, 1999; "be detected by screening a sample of the DNA from blood cells or cells collected from the cheek walls of the mouth" *National Women's Health Report,"* October 31, 1996.

DNA analysis, the same purpose for which applicant's swab sample collection system is used.

We also find that applicant's services of "collecting, analyzing and laboratory testing of cell samples for DNA analysis" are related to the registrant's identified goods. Because lancets are used to collect blood samples, they are an integral component of the cell sample collecting process. Applicant's own evidence shows that it offers both its identified services and materials for obtaining blood samples, including needles. Moreover, the Examining Attorney has made of record third-party registrations which suggest that blood collection kits and medical testing services may be offered by an entity under a single mark.[4]

Applicant also attempts to distinguish the channels of trade and classes of consumers for its goods and services and the goods of the registrant by asserting that its services are used for legal purposes such as paternity determinations and forensic testing in criminal matters, that its products are sold in conjunction with its services, and that its customers are, inter alia, social services agencies and law enforcement organizations. It

[4] See, for example, Registration No. 2,283,546 for, inter alia, kits consisting primarily of needles, tubes, and bags, for use in blood collection and, clinical medical laboratory services in connection with drug testing of insurance applicants, and medical testing of employees at their work sites.

further asserts that registrant sells its products to "sophisticated medical purchasers charged with acquiring medical supplies in bulk and specialized medical equipment for doctor's offices, hospitals or research laboratories." Brief, p. 9.

The primary problem with applicant's argument is that it seeks to impose limitations on both its own and the registrant's identifications that are simply not there. Applicant's goods and services are not limited to social service agencies and law enforcement organizations, and there is nothing in the identification that would restrict it to such channels of trade or customers. Certainly DNA analysis can be used in situations other than determining paternity or identifying criminals. Nor, again, is the registrant's identification restricted to the doctor's offices, hospitals and research laboratories claimed by applicant to be registrant's customers, nor does the identification exclude use of the lancet for obtaining blood samples for DNA analysis.

As noted above, it is well established that, in the absence of any restrictions in the identifications of goods and services, it must be presumed that the goods and/or services are sold in all channels of trade which are appropriate for those goods and services, and to all

appropriate customers. See **In re Davis-Cleaver Produce Company**, 197 USPQ 248 (TTAB 1977); **In re Elbaum**, supra. See also, **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or service to be).

Applicant also argues, at pages 9 and 10 of its brief, that the purchasers of its goods and services and the registrant's goods are sophisticated purchasers who are discerning and careful. Inexplicably, however, in the following paragraph applicant asserts that applicant's customers "typically do not know, much less care, which medical products are used" to answer questions of paternity, and "it is extremely doubtful that the source of such medical products would be of any interest to them." Brief, p. 10. Applicant also states, at page 7 of its brief, that "a lancet is a low-tech, low-cost item." Even if we accept applicant's initial statement that the purchasers of its goods and services and of registrant's are sophisticated and careful, the marks involved are so

nearly identical that even careful purchasers are likely to confuse them. And given the evidence that lancets and sponge-tipped swabs may both be used for DNA analysis, and that companies which provide collecting and laboratory testing of cell samples also provide equipment for obtaining the cell samples, including needles for drawing blood, even sophisticated purchasers would be likely to assume a connection between applicant's products and services and registrant's products if they were sold under the virtually identical marks SOFTOUCH and SOFT TOUCH.[5]

Our decision that confusion is likely is not based on a finding that the registrant's mark is famous; indeed, we have no information regarding registrant's sales and advertising from which we could draw such a conclusion. However, we can say that there is no evidence in this

[5] We note, in this connection, that applicant has submitted evidence from registrant's website which shows that registrant sells a wide variety of medical products, including products used for analysis such as reagents and devices for the isolation and purification of DNA. Applicant recognizes that registrant sells a wide variety of medical products, as indicated at page 7 of its brief (molecular biochemicals used for such activities as protein analysis, cell isolation, and pathology; laboratory systems, such as sample analyzers, heterogeneous ammunoassay analyzers, and assays covering oncology, retrovirus, hepatitis, TORCH, thyroid, fertility, and H. pylori tests; and patient care products, such as blood glucose monitoring system, reflectance photometers, and visual test strips). Sophisticated professionals, knowing the very breadth of medical products offered by registrant, would be even more likely to assume that the sponge-tipped swab collection system, and the collecting and analysis and testing of DNA, would be products and services likely to be offered by registrant.

record that any third parties are using SOFT TOUCH, or any variation of that mark, which would lead us to conclude that the mark is entitled to only a limited scope of protection.

Finally, we address applicant's point that there is no evidence as to any actual confusion. Aside from pointing out the obvious, which is that the statute speaks of likelihood of confusion, applicant's mark has been used for a relatively limited time, since May 1996. The fact that applicant had not encountered any instances of confusion as of July 2000, when applicant submitted the declaration of its Director of Sales and Marketing, or as of November 2000, when its brief was filed, cannot be considered a significant period of time. Further, we have no information from applicant, including from the declaration of its Director of Sales and Marketing, as to its sales, or the amount of money spent on advertising. As such, we cannot conclude from the lack of actual confusion that there has been an opportunity for confusion to occur. This is especially true because applicant, although its identification is not so restricted, has limited its sales and advertising to law enforcement and government agencies, to be used for specific purposes. Therefore, although this duPont factor minimally favors applicant, the other duPont

factors, and in particular the similarity of the marks and the goods/services, strongly favor a finding of likelihood of confusion.

Decision: The refusal of registration is affirmed.